BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Childs et al.	:	Moazzami, Nasser G..
	:	
Serial No.: 10/618,213	:	Group Art Unit: 2187
Filing Date: July 11, 2003	:	
	:	Lenovo (United States) Inc.
Title: AUTONOMIC	:	Building 675
NON-INVASIVE BACKUP AND	:	4401 Silicon Drive
STORAGE APPLIANCE	:	Durham, NC 27709

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I.   REAL PARTY IN INTEREST

At the time of the filing of the above-identified application, International Business Machines Corporation was the assignee of the entire right, title and interest in the above-identified patent application.   International Business Machines Corporation is currently undergoing negotiations with Lenovo (Singapore) Pte. Ltd. to transfer some of its intellectual property to them, including assigning the above-identified patent application to Lenovo (Singapore) Pte. Ltd.

II.   RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III.   STATUS OF CLAIMS

Claims 1-7 are pending in the Application. Claims 1-7 stand rejected. Claims 1-7 are appealed.

IV.   STATUS OF AMENDMENTS

Appellants have not submitted any amendments following receipt of the final rejection with a mailing date of May 8, 2006.

V.   SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1:

In one embodiment of the present invention, a backup system for a computer having a hard drive comprises a program appliance comprising a program attachable in data communication with the computer. Specification, page 5, line 23 – page 7, line 9; Figure 2, elements 203, 207. The backup system may further comprise a data storage appliance attachable in data communication with the computer, where the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive. Specification, page 5, line 23 – page 7, line 9; Figure 2, elements 203, 205, 207.

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-7 stand rejected under 35 U.S.C. under 35 U.S.C. §103(a) as being unpatentable over Appellants' Admitted Prior Art (hereinafter "AAPA") in view of James (U.S. Publication No. 2003/0212862).

VII.   ARGUMENT

The Examiner has rejected claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of James.   Office Action (5/8/2006), page 6. Appellants respectfully traverse these rejections for at least the reasons stated below.

A.   AAPA and James, taken singly or in combination, do not teach or suggest the following claim limitations.

1.   Claim 1 is patentable over AAPA in view of James.

Appellants respectfully assert that AAPA and James, taken singly or in combination, do not teach or suggest "a program appliance comprising a program attachable in data communication with the computer; and a data storage appliance attachable in data communication with the computer" as recited in claim 1. The Examiner cites page 6, lines 14-20 of Appellants' Specification as teaching the above-cited claim limitation. Office Action (5/8/2006), page 6. Appellants respectfully traverse and assert that Appellants' Specification instead teaches that this method of operation is in stark contrast to the prior art, under which a backup program would be installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance. Appellants' Specification, page 6, lines 16-19[1]. There is no language in the cited passage directed to prior art that teaches a program appliance comprising a program attachable in data communication with the computer. Neither is there any language in the cited passage directed to prior art that teaches a data storage appliance attachable in data communication with the computer. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 1, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

In response to Appellants' above argument, the Examiner focuses on Figure 2 of Appellants' Specification (which by the way is not a Figure describing the prior art) and page 6, lines 16-19 of Appellants' Specification and concludes that the only difference between the prior art and Appellants' invention is that the backup program

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[1] It is noted that only lines 16-19 on page 6 of Appellants' Specification refers to the prior art. The rest of the teaching on page 6 of Appellants' Specification refers to the detail description and is not admitted prior art.

is not installed on the hard drive of the computer. Office Action (5/8/2006). The Examiner then states:

> Examiner concluded that AAPA discloses all the limitations being claimed, however, AAPA fails to disclose without installing the program from the program appliance into computer's hard drive. In order to overcome the deficiency of the prior art, James discloses a memory device attachable to the computer and containing application software (program) which is configured to run from the memory device upon connection to the host computer rather than being copied onto computer's hard drive or other permanent storage means. Therefore, it would have been obvious to one having ordinary skill in the art having the teaching of AAPA and James to use the teaching of James into AAPA's backup system in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, thereby improving the security. Office Action (5/8/2006), page 3.

Appellants respectfully assert that the Examiner is ignoring the claim limitation of "a program appliance comprising a program attachable in data communication with the computer." Appellants have not addressed the limitation of "wherein the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive" in the argument above. Instead, Appellants are asserting that the passage cited by the Examiner as allegedly teaching "a program appliance comprising a program attachable in data communication with the computer" does not teach this limitation. Appellants' Specification states:

> Generally, pursuant to the invention, the backup program resident on the program appliance 207 directs the computer 203 to copy the files from its hard drive storage system onto the data storage appliance 205. This method of operation is in stark contrast to the prior art, under which a backup program would be installed on the computer 203 which would then instruct the computer 203 to copy data from the computer 203 hard drive to a data storage appliance 205. Column 6, lines 14-19.

Hence, the passage cited by the Examiner clearly indicates that the <u>program</u> <u>appliance was not used in the prior art</u>. The Examiner is now relying upon Figure 2 of Appellants' Specification, which does show program appliance 207. However, Figure 2 is not illustrating the prior art, but instead, an embodiment of the present invention. As a result of the foregoing, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 1, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Appellants further assert that AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive" as recited in claim 1. The Examiner cites paragraphs [0004], [0011] and [0032] of James as teaching the above-cited claim limitation. Office Action (5/8/2006), page 7. Appellants respectfully traverse.

James instead teaches a portable device for attachment to a personal computer into which data stored in the computer's RAM or on its hard drive may be downloaded. [0004]. James further teaches a memory device containing at least one applications software package and optional associated data, the applications software package being configured to run from the memory device, upon connection thereof to the host computer, by making use of the operating system and processor of the host computer. [0011]. James further teaches that because the applications software and associated data may run from the portable memory device rather than being copied onto the computer's hard drive or other permanent memory storage means, security is much improved, since potentially confidential or personal information is not copied into the computer's permanent memory storage means leaving it vulnerable to potential access by a subsequent user. [0032]. Hence, James teaches a portable memory device that contains application software and associated data where the applications software package is configured to run from the memory device, upon

connection thereof to the host computer, by making use of the operating system and processor of the host computer.

There is no language in the cited passages that teaches a program in a <u>program appliance</u> configured to <u>copy files from a hard drive to data storage appliance</u>. Instead, the cited passages simply teach software in a portable memory device being operable to run data from the memory device instead of having to copy such data onto the computer's hard drive. Neither is there any language in the cited passages that teaches a program in a program appliance configured to copy files from a hard drive to data storage appliance without installation of the program on the hard drive. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 1, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

2.   <u>Claims 2-7 are patentable for at least the reasons that claim 1 is patentable.</u>

Claims 2-7 each recite combinations of features of independent claim 1, and thus claims 2-7 are patentable over AAPA in view of James for at least the reasons that claim 1 is patentable over AAPA in view of James.

3.   <u>Claim 2 is patentable over AAPA in view of James.</u>

Appellants respectfully assert that AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program appliance and the data storage appliance are the same appliance" as recited in claim 2. The Examiner cites Figure 2 of AAPA and the memory device of James as teaching the above-cited claim limitation. Office Action (5/8/2006), page 7. Appellants respectfully traverse.

Figure 2 of Appellants' Specification is not prior art. Figure 2 is directed to an embodiment of the present invention of a hardware configuration. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 2,

since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, the Examiner has not directed Appellants to any language in James to support the assertion that the memory device of James is both a program appliance and a data storage appliance. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that the memory device of James is both a program appliance and a data storage appliance. *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that James inherently teaches that the memory device of James is both a program appliance and a data storage appliance, and that it would be so recognized by persons of ordinary skill. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of obviousness for rejecting claim 2. M.P.E.P. §2143.

In response to Appellants' above argument, the Examiner cites M.P.E.P. §2114 and *Ex parte Masham*, 2 U.S.P.Q.2d 1647 (Bd. Pat. App. & Inter. 1987). Office Action (5/8/2006), page 3. M.P.E.P. §2114 states that "a claim containing a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus' if the prior art apparatus teaches all the structural limitations of the claim." Both the AAPA and the James reference clearly do not teach all the structural limitations of claim 2, which includes the limitations of claim 1. Hence, the citation to M.P.E.P. §2114 and *Ex parte Masham* is improper. Furthermore, *Ex parte Masham* concerns a claim that is directed to the manner of operating the device (e.g., mixing flowing developer material). *Id.* Claim 2 is not necessarily directed to a manner in operating the device. Rather, claim 2 is directed to a structural embodiment. As a result, the citation of M.P.E.P. §2114 and *Ex parte Masham* does not support the Examiner's conclusion that either AAPA or James inherently teaches that the program appliance and the data

storage appliance are the same appliance. The Examiner cannot ignore claim language. All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); M.P.E.P. §2143.03. Since the Examiner has not cited to any passage in either AAPA or James as teaching the above-cited claim limitation, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 2. M.P.E.P. §2143.

<p style="text-align:center">4.   Claims 3 and 7 are patentable over AAPA in view of James.</p>

Appellants respectfully assert that AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program is further configured to execute automatically upon the program appliance being attached to the computer" as recited in claim 3 and similarly in claim 7. The Examiner cites paragraphs [0011] and [0013]-[0014] of James as teaching the above-cited claim limitation. Office Action (5/8/2006), page 8. Appellants respectfully traverse and assert that James instead teaches a memory device containing an applications software package and optional associated data, the applications software package being configured to run from the memory device, upon connection thereof to the host computer, by making use of the operating system and processor of the host memory. [0011]. James further teaches that the discrete, non-volatile memory device is preferably portable, and even more preferably lightweight and small in comparison to the host computer. [0013]. James further teaches that the memory device is advantageously configured as a memory device that may be 'hot-plugged' to a host computer by way of a USB port or other I/O port. [0014]. Hence, James teaches a portable memory device that can be hot-plugged to a host computer by way of a USB port or other I/O port. There is no language in the cited passages that teaches that the program (configured to copy the files from the hard drive to the data storage appliance) is configured to <u>execute automatically upon the program appliance being attached to the computer.</u> Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims

3 and 7, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

In response to Appellants' above argument, the Examiner cites paragraphs [0014] and [0016] of James as teaching the above-cited claim limitation. Office Action (5/8/2006), page 4. Appellants respectfully traverse and assert that James instead teaches that the memory device is advantageously configured as a memory device that may be 'hot-plugged' to a host computer by way of a USB port or other I/O port or any other appropriate releasable connection and which presents itself automatically to the operating system of a host computer as an additional drive, other device or the like. [0014]. James further teaches that the memory device may be disconnected from the first host computer and later connected to a second host computer, where data processing can continue from where it left off in the first host computer. [0016]. Hence, James teaches that the memory device may be hot-plugged to a host computer and present itself automatically to the operating system of the host computer as a drive or device. Presenting itself automatically to the operating system of a host computer as a drive or device is not the same as a program being configured to execute automatically upon the program appliance being attached to the computer. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 3 and 7, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

5.   Claim 4 is patentable over AAPA in view of James.

Appellants respectfully assert that AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive" as recited in claim 4. The Examiner asserts that James teaches the above-cited claim limitation but does not cite to any passage in James as allegedly teaching the above-cited claim limitation. Office Action (5/8/2006), page 8.

In order to establish a *prima facie* case of obviousness, the Examiner must provide evidence that the cited art (AAPA and James) teaches or suggests all of the claim limitations, including the above-cited claim limitation. M.P.E.P. §2143. Since the Examiner has not provided any such evidence, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 4. M.P.E.P. §2143.

In response to Appellants' above argument, the Examiner asserts that the passages of James cited by the Examiner in the Office Action teach the above-cited claim limitation. Office Action (5/8/2006), page 5. Appellants respectfully traverse. None of the passages cited by the Examiner in the Office Action teach a program that is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive. Appellants requested the Examiner to particularly point out which passages in James allegedly teach the above-cited claim limitation. The Examiner refuses to do so. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 4, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

6.   Claim 5 is patentable over AAPA in view of James.

Appellants respectfully assert that AAPA and James, taken singly or in combination, do not teach or suggest "a network in data communications with the computer; and a server computer in data communications with the network, wherein the data communication between the data storage appliance and the computer is provided through the server" as recited in claim 5. The Examiner cites paragraph [0003] of James as teaching the above-cited claim limitation. Office Action (5/8/2006), page 8. Appellants respectfully traverse and assert that James instead teaches that data and applications may be transferred by way of modems and a telecommunications network. [0003]. There is no language in the cited passage that teaches a network in data communications with the computer (where the computer is

in data communication with program of the program appliance). Neither is there any language in the cited passage that teaches a server computer in data communications with the network. Neither is there any language in the cited passage that teaches that the data communication between the data storage appliance and the computer is provided through the server. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 5, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

<p style="text-align:center">7.   <u>Claim 6 is patentable over AAPA in view of James.</u></p>

Appellants respectfully assert that AAPA and James, taken singly or in combination, do not teach or suggest "wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive" as recited in claim 6. The Examiner asserts that AAPA and James, taken together, teach the above-cited claim limitation. Office Action (5/8/2006), page 7. However, the Examiner has not specifically cited to a passage in either AAPA or James as teaching the above-cited claim limitation. In order to establish a *prima facie* case of obviousness, the Examiner must provide evidence that the cited art (AAPA and James) teaches or suggests all of the claim limitations, including the above-cited claim limitation. M.P.E.P. §2143. Since the Examiner has not provided any such evidence, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 6. M.P.E.P. §2143.

In response to Appellants' above argument, the Examiner asserts that the passages of James cited by the Examiner in the Office Action teach the above-cited claim limitation. Office Action (5/8/2006), page 5. Appellants respectfully traverse. None of the passages cited by the Examiner in the Office Action teach a program that is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive. Appellants requested the

Examiner to particularly point out which passages in James allegedly teach the above-cited claim limitation. The Examiner refuses to do so. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 6, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

B.   The Examiner's motivation for modifying AAPA with James to include the missing claim limitation of claim 1 is insufficient to establish a *prima facie* case of obviousness.

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Obviousness is determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). Therefore, an Examiner may often find every element of a claimed invention in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* In order to establish a *prima facie* case of obviousness, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). That is, the Examiner must provide some suggestion or motivation, either in the references themselves, the knowledge of one of ordinary skill in the art, or, in some case, the nature of the problem to be solved, to modify the reference or to combine reference teachings. *See In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Examiner relies on an express or an implicit showing, the Examiner must provide particular findings related thereto. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

The Examiner admits that AAPA does not teach "wherein the program is configured to copy the files from the hard drive to the data storage appliance without

installation of the program on the hard drive" as recited in claim 1. Office Action (5/8/2006), page 7. The Examiner's motivation for modifying AAPA with James to include the above-cited claim limitation is "in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved[2]." Office Action (5/8/2006), page 7. The Examiner's motivation is insufficient to support a *prima facie* case of obviousness for at least the reasons stated below.

The Examiner's motivation ("in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved") does not provide reasons, as discussed further below, that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify AAPA to include the missing claim limitation of claim 1. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-7. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

The Examiner cites column 6, lines 14-20 of Appellants' Specification for the teaching of AAPA. Office Action (2/01/2006), page 4. Appellants' Specification teaches that this method of operation is in stark contrast to the prior art, under which a backup program would be installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance. Appellants' Specification, page 6, lines 16-19. The Examiner has not provided any reasons as to why one skilled in the art would modify AAPA, which teaches a backup program would be installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance, to have program configured to copy the files from the hard drive to the data storage appliance

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[2] The Examiner appears to be citing from [0032] of James.

without installation of the program on the hard drive (missing claim limitation of AAPA). The Examiner's motivation ("in order not to copy potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved") does not provide such reasoning. The Examiner has not explained how "not copying potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved" relates to a backup program installed on the computer which would then instruct the computer to copy data from the computer hard drive to a data storage appliance. Neither has the Examiner explained how "not copying potentially confidential or personal information into the computer's permanent memory storage means, leaving it vulnerable to potential access by a subsequent use of the computer system, so that the security is much improved" relates to having a program configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive. Hence, the Examiner's motivation does not provide reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would modify AAPA to include the missing claim limitation of claim 1. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-7. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

        C.   <u>Examiner has not provided motivation for modifying AAPA to include the limitations of claims 3, 4, 5 and 7.</u>

In order to establish a *prima facie* case of obviousness, the Examiner must submit some suggestion or motivation to modify the reference to combine reference teachings. M.P.E.P. §2143. The Examiner admits that AAPA does not teach the limitations of claims 3, 4, 5 and 7. Office Action (5/8/2006), pages 7-8. The Examiner modifies AAPA with James to include the missing claim limitations of claims 3, 4, 5 and 7. Office Action (5/8/2006), pages 7-8. However, the Examiner

fails to present any motivation for modifying AAPA to include the missing claim limitations of claims 3, 4, 5 and 7. Hence, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 3, 4, 5 and 7. M.P.E.P. §2143.

In response to Appellants' above argument, the Examiner states:

> [T]here is no requirement that a motivation to make the modification be expressly articulated. The test for combining references in what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 U.S.P.Q. 209 (C.C.P.A. 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 U.S.P.Q. 545 (C.C.P.A. 1969). Office Action (5/8/2006), page 5.

Appellants respectfully contest the Examiner's position to the extent that the Examiner contends that he does not have to provide any evidence to support a suggestion or motivation for combining references. The Examiner must provide independent evidence to support the assertion that the suggestion to combine references comes from the knowledge and common sense of a person of ordinary skill in the art. *See Smiths Industries Medical Systems Inc. v. Vital Signs Inc.*, 51 U.S.P.Q.2d 1415, 1421 (Fed. Cir. 1999). The reliance on "*common knowledge and common* sense" may not be substituted for evidence. *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Federal Circuit in *In re Lee* specifically held that *Bozek* did not hold that common knowledge and common sense are a substitute for evidence. *Id.* Nor does *Bozek*, after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Circuit of Customs and Patent Appeals that determination of patentability must be based on evidence. *Id.* The Examiner must submit objective evidence in support of modifying a reference. *In re Lee* at 1434; *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-1317 (Fed. Cir. 2000). The factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. *In re Lee* at 1434. Since the Examiner has not provided any objective evidence in support of modifying AAPA with James to

include the missing claim limitations of claims 3, 4, 5 and 7, the Examiner has not established a *prima facie* case of obviousness in rejecting claims 3, 4, 5 and 7. *Id.*
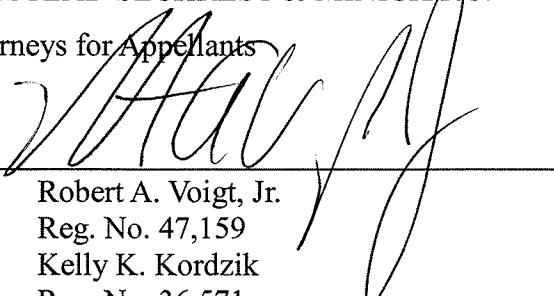
VIII.   CONCLUSION

For the reasons noted above, the rejections of claims 1-7 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-7.

Respectfully submitted,

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CLAIMS APPENDIX

1.   A backup system for a computer having a hard drive comprising:

a program appliance comprising a program attachable in data communication with the computer; and

a data storage appliance attachable in data communication with the computer,

wherein the program is configured to copy the files from the hard drive to the data storage appliance without installation of the program on the hard drive.

2.   The backup system of claim 1 wherein the program appliance and the data storage appliance are the same appliance.

3.   The backup system of claim 1 wherein the program is further configured to execute automatically upon the program appliance being attached to the computer.

4.   The backup system of claim 1 wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive.

5.   The backup system of claim 1 further comprising:

a network in data communication with the computer; and

a server computer in data communication with the network,

wherein the data communication between the data storage appliance and the computer is provided through the server.

6.   The backup system of claim 5 wherein the program is further configured to copy the files from the data storage appliance to the hard drive without installation of the program on the hard drive.

7.   The backup system of claim 5 wherein the program is further configured to execute automatically upon the program appliance being attached to the computer.

EVIDENCE APPENDIX

No evidence was submitted pursuant to §§1.130, 1.131, or 1.132 of 37 C.F.R. or of any other evidence entered by the Examiner and relied upon by Appellants in the Appeal.

RPS920030060US1   PATENT

RELATED PROCEEDINGS APPENDIX

There are no related proceedings to the current proceeding.